



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

William HILL et al.

Serial No.: 09/479,979

Filed: January 10, 2000

For: METHOD AND SYSTEM FOR
DYNAMICALLY ADAPTING THE
LAYOUT OF A DOCUMENT TO AN
OUTPUT DEVICE

Atty. Docket No.: 003797.00335

Group Art Unit: 2178

Examiner: C. Huynh

Confirmation No.: 3757

PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Appellants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

REMARKS/ARGUMENTS

Having received and reviewed the final Office Action dated November 28, 2005 and the Advisory Action dated February 10, 2006, Appellants respectfully submit that the current rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005. Claims 35-53 are pending in this application.

There is one outstanding rejection in the instant application; claims 35-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibata et al., Dynamic Hypertext and Knowledge Agent Systems for Multimedia Information Networks, ACM 1993, pages 82-93,

("Shibata"), in view of U.S. patent no. 5,557,722 to DeRose et al. ("DeRose"). For the details of this rejection refer to paper no. 11152005, pages 3-7.

The specific error relied upon in this Pre-Appeal Brief Request for Review pertains to the action's assertion that Shibata, by implication, teaches the claimed feature of interrogating the output device to determine a set of capabilities of the output device in response to a request for the document as recited in claim 35. Appellants interpret this position to mean that the claimed feature is inherent from Shibata and must occur. In any event, appellants have rebutted the inherency argument and offered other plausible methodologies by which Shibata could have determined a set of capabilities of the output device in the Response To Final Rejection, paper no. 01232006, pages 5-7.

The Advisory Action, paper no. 02062006 maintains that the alternatives presented in the Response To Final Rejection are unreasonable:

respectfully disagrees. As addressed in the final action, the two offered reasons are not reasonable. First, conventionally a user never needs to include the information of the workstation capabilities when requesting for a document. Second, it does not make sense that the knowledge agent has to store user's workstation locally. Why the agent has to waste memory storing all users' workstation capabilities whereas not every user requests document. Therefore, converting the media format to a format conforming to the capabilities of the user's workstation when the knowledge agent receives a user request for a document in Shibata does implies interrogating the capabilities of the output device in response to a user's request.

The action's interpretation of the proposed alternative methodologies to determine a set of capabilities of the output device is flawed as set forth in Response To Final Rejection. In rebutting inherency, the existence of alternatives is what is important. Appellants have established that alternatives exist and the action has essentially admitted the same by attacking the desirability, rather than the possibility of such alternatives. Moreover, appellants disagree with the characterization that is unreasonable to pursue these alternatives. Namely, it is not necessarily a waste of money to store all workstation capabilities locally. For example, the expense of storing the workstation capabilities locally should be considered, which may depend on factors such as how many different workstations are available, and the impact of processing speed. Also, particular environments may dictate storing capabilities locally rather than interrogating the devices to determine their capabilities.

Appellants submit that Shibata does not teach or suggest interrogating the output device to determine a set of capabilities of the output device in response to a request for the document as recited in claim 35. DeRose fails to remedy this defect. As such, the combination of Shibata and

DeRose, even if proper, does not result in the claim 35 combination of features. The arguments set forth with respect to claim 35 apply as well to claims 36-41, which depend from claim 35, independent claims 42 and 48, which each call for a feature substantially similar to that discussed with respect to claim 35, and claims 43-47 and 49-53, which ultimately depend from claims 42 and 48, respectively.

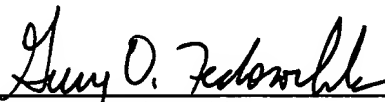
CONCLUSION

All issues having been addressed, appellants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3223

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: February 21, 2006

By:



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